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IN THE

SUPREME COURT OF THE UNITED STATES

October Term, 1985

EWP CORPORATION and
LA SOCIETE TREFILUNION,
Petitioners,

v.

RELIANCE UNIVERSAL INC., and
EXPOSIAC INDUSTRIES, INC.,
Respondents.

Petitioners' Reply to Brief in Opposition to Petition for Writ of Certiorari

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INTRODUCTION

Respondents' "distilled essence" of the "Questions Presented" by the petition completely emasculates and misrepresents the vitally important issues raised by the petition. Those issues need to be determined now by this Court in order to give guidance to the newly created Court of Appeals for the Federal Circuit (CAFC) so that it will perform correctly the judicial function granted to it for the field of patent law.

Respondents must have recognized that need, for they have advanced no answers to the actual questions presented and have been forced to resort to an alleged distillation process which defies science and technology. Indeed, their brief invites a quotation from the minority opinon of Judge Miller in *Woods* v. *Tsuchiya*, 754 F.2d 1571, 1583 (Fed. Cir. 1985), in criticizing the assumption of the role of fact finder by the majority of the panel:

> "When *I* use a word," Humpty Dumpty said, in a rather scornful tone, "it means just what I choose it to mean — neither more nor less." L. Carroll, *Alice's Adventures in Wonderland* . . . Also apt is Alice's comment: "I've often seen a cat without a grin . . . but a grin without a cat! It's the most curious thing I ever saw in all my life!"

Question I

Respondents have treated Question 1 of the petition as asking whether the CAFC is *sometimes* subject to the review constraints established by this Court, as most recently reaffirmed in *Anderson* v. *Bessemer City*, 84 L.Ed.2d 518:

> (R)eview of factual findings under the clearly-erroneous standard — with its deference to the trier of facts — is the rule, not the exception.

This *no-exception* directive — and the sentence which precedes it in the quotation on page 11 of the petition — match the Notes of the Advisory Committee on Rules in connection with the 1985 amendment of Rule 52(a):

> To permit courts of appeals to share more actively in the fact-finding function would tend to undermine the legitimacy of the district courts in the eyes of litigants, multiply appeals by encouraging appellate retrial of some factual issues, and needlessly reallocate judicial authority.

In answering their *sometimes* version of Question 1 affirmatively, respondents have ignored the evidence presented in the petition that the CAFC seems to feel subject to the review constraints mandated by this Court only when that suits the end result which it wants, and to feel free to ignore them when it so chooses. Petitioners submit that there is no other explanation for the steady increase in petitions to this Court based on precisely that point.

In this connection, and in addition to the total of ten cases noted on page 21 of the petition, *Lex Tex Ltd. Inc.* v. *J.P. Stevens & Co.*, No. 84-1858 includes the same "Comparative Analysis" reproduced on page A-51 of the present petition, and urges that the CAFC "has misconceived the mission and powers assigned to it by Congress . . . by usurping the fact-finding functions of the United States District Courts . . ." *Rol Mfg. Co.* v. *Nickson Industries, Inc.*, No. 85-26 raises to 12 the number of petitions complaining of *de novo* fact-finding by the CAFC.

Respondents' reliance on the CAFC's selective deference to Rule 52(a) also ignores the criticism on that point which has developed within the CAFC itself. To the examples cited in the last paragraph on page 22 of the petition should be added the dissent in *RCA Corp.* v. *Applied Digital Data Systems, Inc.*, 730 F.2d 1440, 1448 (Fed. Cir. 1984), and also *Woods* v. *Tsuchiya*, supra.

Finally on this issue, a very recent commentary[1] pointed out that in the present case, the CAFC reversed the trial judge's determination of nonobviousness

> despite the Federal Circuit's accepting the trial court's finding of significant commercial success causally related to the claimed invention. The basis for the reversal and holding by the CAFC of obviousness was exclusively its own technological analysis of the prior art . . .

The same commentary quotes from a published speech by CAFC Chief Judge Markey: "Federal Circuit judges are working a minimum of 60 hours a week, some more than that. They are harassed and pressed to get the work accomplished." The commentary continues:

> The unnecessary and inordinate amount of time that the [ten] Federal Circuit panels were obliged to put in in finding rational threads. . . . to reverse in *Fromson*, 755 F.2d 1559 (Fed. Cir. 1985) and in *EWP Corp.* is a price that neither the Circuit Judges nor society should have to pay. (Appendix C-2, C-3)

Question II

Respondents' "there is no conflict" reply to Question 2 simply denies the existence of the multiple conflicts between the decision below and prior decisions of other panels of the CAFC discussed in the petition and in connection with Question 4 below. The following comments of Professor Kayton are also directly in point:

> As part of the claimed invention "as a whole," the court in *Perkin-Elmer Corp.* v. *Computervision Corp.*,

---

[1] "Anticipation and Obviousness in the Federal Circuit 1984-1985" by Irving Kayton, Chapter Q of "Federal Circuit Patents & Statutory Changes 1984-1985" published by Patent Resources Group, Washington, D.C. All discussions therein of the present case are reproduced in attached Appendix C.

> 732 F.2d 888 (Fed. Cir. 1984) . . . relied on a preamble recitation as a limitation to distinguish over the prior art and to find the claim valid. Under virtually identical facts, however, Circuit Judge Rich in *EWP Corp.* refused to construe a preamble recitation as a limitation in the claim and as a consequence found the claim obvious over the prior art, an impossibility had he read that preamble recitation as a limitation in the claim. (Appendix, C-4)

Question III

Respondents' "distilled essence" of Question 3 seriously misrepresents the actual question, which is directed to the increasing propensity of the CAFC for substituting its own fact findings for those of the trial court without finding the latter to be clearly erroneous. As Judge Miller so succinctly pointed out by his *Alice in Wonderland* reference quoted above on page 1, it accomplishes that result of circumventing the applicable review constraints either by the device of declaring fact issues to be legal issues or by stating that the "approach" of the trial court was wrong.

Precisely that propensity permeated the decision of the CAFC here, but as pointed out on pages 14-15 of the petition, the attempts of the CAFC to find error in the trial judge's "approach to the issue" of nonobviousness resulted in substituting its own fact-findings, which were clearly contrary to the record, for the trial court's findings that were supported by the same evidence misconstrued by the CAFC.

Question IV

Respondents' distillation of Question 4 totally ignores the legal proposition and supporting authorities noted on page 15 of the petition, and it complements that omission by a reply which misses even its own "strawman" version of the question as well as the applicability of the real Question 4 to the decision in issue.

The whole point of Question 4 is that while the CAFC *had* been highly consistent in requiring application of the statutory presumption of validity by the district courts, its decision in the present case is in violent contrast with its own precedents. Note, for example, *RCA Corp.*, supra p. 2:

> The only error of the court was in its failure to start with the presumption that the patent was valid . . .

In *Perkin-Elmer Corp.* v. *Computervision Corp.*, supra p. 3, the Court cited two of its own earlier cases as authority for this proposition:

> Included within the presumption of validity mandated by 35 U.S.C. § 282 is a *presumption of nonobviousness* which the patent challenger must overcome by proving facts with clear and convincing evidence. (emphasis supplied)

When those pronouncements, and the other precedents discussed on pages 16-17 of the petition, are contrasted with the present case and respondents' related comments, it becomes crystal clear that respondents lack any basis for challenging petitioners' position on the statutory presumption issue. That weakness is further emphasized by the only two cases which they cite, which actually give strong support to petitioners.

Thus in *Medtronic, Inc.* v. *Cardiac Pacemakers, Inc.*, 721 F.2d 1563, 1567 (Fed. Cir. 1983), the CAFC criticized the approach of the trial court to the issue of validity in language which is directly applicable to its own actions in the present case:

> Judge Devitt stated: "Recognizing the presumption of validity, we must satisfy ourselves in light of the evidence before us that the patents in suit [sic patented inventions] possess the essential characteristics of utility, novelty and nonobviousness." It is of course true that to be patentable an invention must be useful, novel, and nonobvious. The cited cases do not hold, however, that a

> court may merely "recognize" the presumption and then proceed to "satisfy" itself that an invention possesses such characteristics. The statute, 35 U.S.C. § 282 requires that the court begin by presuming that the invention has those characteristics. To do otherwise is to ignore the statute and to place on the patentee a non-statutory burden of proving validity. The court must be satisfied of something quite different, namely that the party challenging validity has carried its burden of overcoming the presumption.

Respondents' other citation, *Railroad Dynamics, Inc.* v. *A. Stucki Co.*, 727 F.2d 1506, 1511 (Fed. Cir. 1984), was an appeal from the denial of a motion for JNOV following a jury verdict of validity and infringement. In affirming the trial court, the CAFC said:

> The burden placed on patent challengers by § 282 is not undue. There are many grounds for challenging a patent. Challengers often press them all; and challengers win if they establish only one.
>
> When a jury verdict of validity is tested by a motion for JNOV, therefore, the district court must determine whether the patent challenger's evidence met the burden imposed by § 282. If that evidence be such as to have so withstood the patent owner's rebuttal evidence that reasonable jurors could not have concluded that the patent is valid, the motion should be granted. If the patent challenger's evidence fails that test, the motion should be denied.

Petitioners urge that there should be no difference in principle between this test spelled out by the CAFC for the trial court to use in assaying a jury verdict of validity, and the constraints on the CAFC itself in reviewing the judgment of a trial court in a non-jury case that the patent challenger's evidence failed to meet the burden imposed by § 282.

It is a major tenet of the present petition that the CAFC's

de novo rehearing was in direct conflict with its own standards enunciated in all of the above-noted cases, and especially in *Railroad Dynamics* as well as *Medtronic*. Not only did respondents' evidence fail the test before the trial court, but respondents have now failed to meet petitioners' challenge to that violation by the CAFC of its own standards.

Question V

The "distilled" version of the petition's Question 5 destroyed the "essence" of the original question — which is specifically concerned with the CAFC's conflict with its own precedents in substituting its own speculative rationalizations for the trial court's findings of "convincing" objective evidence of nonobviousness.

Thus in *Simmons Fastener Corp.* v. *Illinois Tool Works, Inc.*, 739 F.2d 1573 (Fed. Cir. 1984), the CAFC specifically agreed with the trial court that the teachings of the prior art prima facie would have suggested the claimed invention to one of ordinary skill in the art, but it reversed the judgment of obviousness on the ground that the evidence of secondary considerations, particularly commercial success, was extremely strong and entitled to great weight.

In the present case, the trial court found that the defendants' prior art evidence failed to overcome the presumption of patent validity, and that the conclusion of nonobviousness was persuasively supported by the evidence of long felt need and "immediate and extensive" commercial success. (Petition, page A-42)

In direct conflict with its own precedents, the CAFC reached an initial conclusion of obviousness. (Petition, pp. A-11 to A-14) Only on the last page (A-15) did the Court touch on the evidence of secondary considerations, state that "we remain convinced" of obviousness, and then, as an apparent after-thought, attempt to deprecate the trial court's finding of "persuasive evidence" by substitutiong its own speculative rationalizations about "astute businessmen" which were in conflict with the evidence on which the trial court's findings were based.

Respondents' Conclusion

Respondents would have difficulty in finding agreement that there is ever a "routine" patent case. Certainly the present case was highly distincitve at the trial level by reason of the exceptional degree of objective evidence of nonobviousness, as well as unique at the appellate level in the number of precedent decisions — by this Court as well as the CAFC — with which it is in conflict.

Respondents' representation that "the decision below breaks no legal ground, (and) departs from no established principles" is also directly rebutted by Professor Kayton:

> In fact, the *EWP* court dealt a body blow to the objective indicia of nonobviousness from which it may take a long time to recover. . . . Judge Davis's concurrence, it must be unhappily noted, virtually stood the objective indicia of nonobviousness on their heads. (Appendix C-6)

> Circuit Judge Davis pointed out that the references were *foreign* patents; this explained, in his mind, why *American* inventors would not have known about these prior art references at the time the invention was made and, thus, why the invention would have been obvious to a person of ordinary skill in the art.

> In short, because *American* inventors (a geographic constraint upon obviousness/nonobviousness heretofore unheard of by this author) may be less aware of foreign patents than other prior art, Circuit Judge Davis suggested that the references were simply not readily accessible. However, he gave no explanation as to why people of ordinary skill in the art in France and Germany would not have invented were the claimed invention obvious to them, since concrete pipe technology is in no way restricted to the United States. (Appendix C-7)

The second point in those quotations is particularly ironic in view of the fact that the inventor of the patent in suit was a

Frenchman employed by a French manufacturer of wire reinforcing mesh for concrete pipe.

Conclusion

The issues as developed in the petition and subsequent briefs apply to all cases involving 35 U.S.C. § 103 and are in no way limited to the present case. In addition, petitioners urge that the technological facts of this case are so simple and the issues so clearly defined as to make it ideal for the grant of certiorari by this Court to ensure that the CAFC properly function in the future under the same *no-exception* review standard as this Court requires of other federal courts of appeal.

Respectfully submitted,

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ANTICIPATION AND OBVIOUSNESS IN THE FEDERAL CIRCUIT 1984-1985*

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In *Fromson* v. *Advance Offset Plate*, 755 F.2d 1549 (Fed. Cir. 1985), Chief Judge Markey pointed out that the trial court specifically held that the patent in suit combines steps A, B and C in one process and nowhere "did the court indicate, nor does the record indicate, a basis on which it can be said that the making of that combination would have been obvious when it was made." He then further points out that the trial court asserted that a combination patent comprised exclusively of old elements was characteristic of the patent in suit and suggested that somehow a different standard of patentability should be applied thereto. * * * But in this instance, in *Fromson*, Chief Judge Markey, with Circuit Judge Davis and Senior Circuit Judge Nicholas, reversed. In further support for the reversal, the court pointed to an extraordinary degree of commercial success clearly causally related to the claimed invention, which the trial judge in essence had refused to consider because he essentially determined the invention to have been obvious in a technological sense and said that "The secondary considerations Fromson cites do not and cannot make the Fromson patent valid." Such a refusal to consider the objective indicia of nonobviousness ("secondary considerations") automatically makes any determination of

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* Substantial portions of this text have been drawn by the author from an earlier paper entitled "Federal Circuit Patent Law, 1983 - Mid-1984," by Herbert H. Mintz, a partner in Finnegan, Henderson, Farobow, Garrett & Dunner, Washington, D.C.

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obviousness subject to remand for further consideration with all the evidence on the subject of obviousness *vel non*.

So what then is the problem? Is it not clear that the trial judge should have been reversed and the patent held valid? Categorically, no! Remand was what was appropriate! Under the law of the Federal Circuit, as enunciated the very same day (February 21, 1985) that *Fromson* v. *Advance Offset* came down, the court under the pen of Circuit Judge Rich, on a panel with Judges Davis and Baldwin, reversed a trial judge's determination of *non*obviousness, in *EWP Corporation* v. *Raliance Universal*, despite the Federal Circuit's accepting the trial court's finding of significant commercial success causally related to the claimed invention. The basis for the reversal and holding by the CAFC of obviousness was exclusively its own technological analysis of the prior art which it believed fairly taught the claimed invention to a person of ordinary skill in the art.

The simultaneous publication of *Fromson* and *EWP Corporation* demonstrates that the Federal Circuit is laboring with far too large an oar in its review proess when the trial judge has committed serious errors of law with respect to validity. The proper response must be remand for further consideration consistent with the legal opinion of the appellate court.

* * *

The Circuit Judges of the Federal Circuit surely appear to be a hard-working, overburdened group.

> "[T]he Federal Circuit judges are working a minimum of 60 hours a week, some more than that. They are harassed and pressed to get the work accomplished. We are no longer able to enjoy Frankfurter's suggestion that a judge requires tranquility * * * weekends, wee hours of the morning are standard."[13]

The unnecessary and inordinate amount of time that the ten Federal Circuit panels were obliged to put in in finding ra-

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[13] Markey, "A View from the Bench," AIPLA Bulletin, September-October-November, 1984.

tional threads to affirm the above-cited trial courts (and the two panels to reverse in *Fromson* and in *EWP Corp.*) is a price that neither the Circuit Judges nor society should have to pay. The Federal Circuit judges should be spending their time on properly presented cases and simultaneously using their time efficiently in educating the errant trial bench below.

* * *

D. Differences Between the Claimed Invention and the Prior Art

Once the scope and content of the prior art are ascertained, the *Graham* pattern of analysis calls for elucidation of the differences between the prior art and the invention. In § 103, the statute expressly requires that obviousness or nonobviousness be determined for the claimed subject matter "as a whole," and the key to proper determination of the differences between the prior art and the invention is giving full recognition to the invention "as a whole".

In *Jones* v. *Hardy*, 727 F.2d 1524, (Fed. Cir. 1984), the Federal Circuit reversed a district court holding of invalidity of patents relating to the use of molded polystyrene sheets in the formation of concrete walls, finding numerous errors in the district court's assessment of obviousness, including a failure to consider the invention "as a whole". A basic error along this line was judging the obviousness of the "idea" behind the invention. The Federal Circuit held that:

> The invention cannot be tested on the basis of whether the "idea" of using molded polystyrene is patentable. Under the patent statute, Title 35 USC, "ideas" are not patentable; claimed structures and methods are. Reducing a claimed invention to an "idea," and then determining patentability of that "idea" is error. [Citation omitted.] Analysis properly begins with the claims, for they measure and define the invention.

In the same vein, the district court in *Jones* treated the differences between the claimed invention and the prior art as

the invention itself. Rejecting this denigration of the claimed invention "as a whole," the Federal Circuit observed that:

> The "difference" may have seemed slight (as has often been the case with some of history's great inventions, e.g., the telephone), but it may also have been the key to success and advancement in the art resulting from the invention. Further, it is irrelevant in determining obviousness that all or all other aspects of the claim may have been well known in the art.

As part of the claimed invention "as a whole," the court in *Perkin-Elmer Corp.* v. *Computervision Corp.*, 732 F.2d 888, (Fed. Cir. 1984), held that recitations in the preamble can be limitations where they "are necessary to give meaning to the claim and properly define the invention." Chief Judge Markey relied on a preamble recitation as a limitation to distinguish over the prior art and to find the claim valid. Under virtually identical facts, however, Circuit Judge Rich in *EWP Corp.* v. *Reliance Universal, Inc.*, refused to construe a preamble recitation as a limitation in the claim and as a consequence found the claim obvious over the prior art, an impossibility had he read that preamble recitation as a limitation in the claim.

Perkin-Elmer involved an optical system of mirrors to form an image that can be used to trace a design on a silicon wafer to form a semiconductor. The patent claims were to a "unity magnification catoptric [i.e., using only mirrors] image-forming system comprising * * *," with the body of the claim describing the nature of the mirrors and their relationship to each other, the object, and the image. Without elaboration, the Federal Circuit held the claimed system to be unity magnification and image-forming, characterising these preamble limitations as necessary to give meaning to the claims and properly define the invention.

In *E.W.P. Corp.* v. *Reliance Universal*, the claim in suit was a process for making a reinforced cement pipe. There were extensive findings of fact establishing that the reinforced concrete pipe made by that process satisfied a long-felt need

in the concrete pipe industry and was adopted widely. Circuit Judge Rich, however, refused to read the preamble recitation dealing with concrete pipe into the process claim. He simply viewed the claimed invention as a process for crimping the reinforcing bars as separate entities unrelated to their use in the concrete pipe. As a consequence, he found the claims obvious over the prior art dealing with crimping various forms of wire and elongated metallic elements. It is difficult to see any real distinction upon which to base the dichotomy of claim construction (always a matter of law) exhibited between Chief Judge Markey in *Perkin-Elmer* and Circuit Judge Rich in *E.W.P. Corp.* (Circuit Judge Baldwin sat on both panels).

* * *

(O)nce *prima facie* obviousness is established, the applicant must rebut it if he can. Here the objective indicia of nonobviousness come powerfully into play.[71]

The objective evidence of nonobviousness present in *Perkin-Elmer Corp.* v. *Computervision Corp.*, 732 F.2d 888, (Fed. Cir. 1984), was held to support the jury verdict of nonobviousness which was sustained by the trial court. *Perkin-Elmer* involved patents said to disclose the optical structure of a projection printer sold under the name "Micralign" whereby a circuit design is traced onto a silicon wafer through optics in the manufacture of semiconductor integrated circuits. The Federal Circuit summarized the collection of objective facts relating to the '015 and '736 Perkin-Elmer patents in suit, stating that:

> The record contains strong objective evidence — which Computervision does not contest — in support of the nonobviousness conclusion. It was stipulated that the Micralign projection printer, having as its critical element the optical system of the '015 and '763 patents, was an outstanding commercial success and was the first commercially successful projection printer for use in the manufacture of semiconductor integrated circuits.

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[71] But see *EWP Corp.* v. *Reliance Universal.*

> Testimony unchallenged on appeal established that the Micralign had numerous advantages over previous printers, became the industry standard, revolutionized the industry, and satisfied a long felt need; unchallenged testimony also showed surprise at the exceptional results achieved by the invention claimed in the '015 patent, and the radial departure from traditional approaches to lens design represented by the invention claimed in the '763 patent.

The Federal Circuit affirmed the holding of validity in *Perkin-Elmer* even though in order to do so, it was obliged to read a claim preamble recitation as a term of limitation.

The patentee did not fare nearly as well at the hands of Circuit Judge Rich's pen in *EWP Corp.* v. *Reliance Universal*. In fact, the *EWP Corp.* court dealt a body blow to the objective indicia of nonobviousness from which it may take a long time to recover. In *EWP*, Circuit Judge Rich and the rest of the panel refused to read the method claim to include as a limitation an explicit recitation in the claim's preamble (something that was readily done by Chief Judge Markey in *Perkin-Elmer*, supra). With that limitation not in place, Circuit Judge Rich proceeded to find the claim obvious over the prior art despite an abundance of findings of fact by the trial court (which had held the claim unobvious over the prior art) that indicated extensive objective indicia of nonobviousness, not the least of which was long-felt and unsatisfied need in the concrete pipe industry (the term "concrete" being the limitation refused the patentee from the preamble) and extensive commercial success. Both Circuit Judge Rich, in the majority opinion, and Circuit Judge Davis, in his concurrence, indicated lack of strong faith in the degree and extent of the objective indicia of nonobviousness without at any point reversing any of the trial court's findings of fact as clearly erroneous.

Circuit Judge Davis's concurrence, it must be unhappily noted, virtually stood the objective indicia of nonobviousness on their heads. Both Circuit Judges Rich and Davis made

reference to French and German patents that were quite old prior art. It was this art, not considered by the Patent Office, which both judges felt rendered the claims obvious. Circuit Judge Davis pointed out that the references were *foreign* patents; this explained, in his mind, why *American* inventors would not have known about these prior art references at the time the invention was made and, thus, why the invention would have been obvious to a person of ordinary skill in the art.

In short, because *American* inventors (a geographic constraint upon obviousness/nonobviousness heretofore unheard of by this author) may be less aware of foreign patents than other prior art, Circuit Judge Davis suggested that the references were simply not readily accessible. However, he gave no explanation as to why people of ordinary skill in the art in France and Germany would not have invented were the claimed invention obvious to them, since concrete pipe technology is in no way restricted to the United States. Most disturbing was Circuit Judge Davis's circular reasoning that the fact that the references were so old, and no one had invented before the patentee, was proof that the references had been inaccessible and the claimed invention was obvious (rather than the opposite), because had they been accessible, the invention would have been made long before.